

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hiroyuki KISHI

Application No.: 09/986,026

Group Art Unit: 3694

Filed: November 7, 2001

Examiner: Kirsten Sachwitz APPLE

For: METHOD, PROGRAM AND APPARATUS FOR COLLECTING PURCHASE
INFORMATION USING NETWORK

REPLY BRIEF UNDER 37 CFR 41.41

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Commissioner for Patents

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This is a Reply Brief in response to the Examiner Answer mailed August 20, 2009.

This Reply Brief complies with 37 CFR 41.39(b)(2) by requesting the appeal be maintained and addressing the new ground of rejection as set forth in 41.37(c)(1)(vii) and in view of MPEP 1207.03 (e.g., 1207.03-V.B).

This Reply Brief is timely filed on October 20, 2009, entry of which is requested.

If any further fees are required in connection with this filing, please charge our Deposit Account No. 19-3935.

I. STATUS OF CLAIMS

Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 are rejected.

Claims 5, 10, 13-15, and 18-19 are cancelled.

Rejection of claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 is appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 6, and 11-12 are newly rejected under 35 USC 101 as being directed to non-statutory subject matter, thus, the Examiner Answer contains a New Ground of Rejection in relation to the final Office Action of February 26, 2008.

Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 are rejected under 35 USC 103(a) as being unpatentable over Quinlan (US Patent No. 6,748,365) in view of Solomon (US Patent No. 6,847,935).

III. ARGUMENTS

I. Claims 1-4, 6, and 11-12 are newly rejected under 35 USC 101 as being directed to non-statutory subject matter. A first issue is whether the Office Action has established a prima facie case unpatentability based upon the non-statutory subject matter rejection of claims 1-4, 6, and 11-12 under 35 USC 101.

This is a New Ground of Rejection in relation to the final Office Action of February 26, 2008, because the final Office Action of February 26, 2008 did not include any rejections under 35 USC 101.

Appellant addresses this new ground of rejection as follows:

The independent method claims 1 and 11 are rejected under 35 USC 101 for allegedly being directed to non-statutory subject matter. The Examiner Answer, item (6), on page 3 (see also Examiner Answer, item (9), page 9), appear to rely on In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008) and asserts that a claimed process must either (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter. In particular, the Examiner asserts that independent method claim 1 "lack of structure, such as 'computer readable medium.'" The Examiner Answer page 3 suggests amending the claims to recite 'electronically' or 'on computer (or other appropriate structure).'

The USPTO New Interim Patent Subject Matter Eligibility Examination Guideline of August 24, 2009 (Interim Guideline) provides most recent USPTO guidance for subject matter eligibility for method claims in view of In re Bilski.

The language of claim 1 provides "1. (Previously presented) A purchase information collecting method for collecting information on a purchaser of one or more commodities **using a network with a server apparatus**, the method comprising:," thus complying with USPTO's current 35 USC 101 statutory subject matter requirement by expressly tying the method to a particular apparatus (i.e., "**a network**" and "**a server apparatus**"). The limitation "**using a network with a server apparatus**" is more than a field-of-use limitation, because the required claim language imposes a meaningful limit on the claim's scope, so the claim does not embrace an abstract idea, mental process or substantially all practical uses of a law of nature or a natural phenomenon, by requiring **purchase information collection use a network with a server apparatus**. In other words, the language of claim 1 requires a network and a server apparatus implement the recited method. See Interim Guideline II.B, definition of 'field of use.'

Further, the language of claims 1 and 11, using claim 1 as an example, requires **storing information** in **"a first storing part"** and **"a second storing part"** which fall under the 35 USC 101 'machine' statutory subject matter class by being a storage device under the broadest reasonable interpretation in light of the specification (see Interim Guideline II.B). The Examiner Answer page 3 asserts that 'claim also includes 'storing upon' which is insufficient since the machine need to be performing the method not just acted upon.' It is readily apparent under broadest reasonable interpretation in light of the specification that the actions of 'storing' in claims 1 and 11 are performed electronically by a computer. In other words, the claim language **"storing the received first sales information in a first storing part"** (claim 1) and **"storing the first deal identifying information in a first storing part,"** (claim 11) in light of FIG. 1 and hard disks 13, 35 and 25, require the act of electronic storing. The Examiner Answer page 3 acknowledge that placing the phrase '**electronically**' before an action verb, namely, before the term **"storing"** as **electronically storing** can overcome the rejection, however, it is submitted that such an amendment is not necessary when the broadest reasonable interpretation in light of the specification of the claim language **"storing ... in a first storing part"** covers electronically storing in a storage device, for example, hard disks 13, 35 and 25 (as the case maybe).

In addition, the Examiner Answer page 3 asserts that the phrases of **"storing ... in a first storing part"** and **"storing ... in a second storing part"** are insufficient or insignificant extra solution activity, however, claim 1 requires **"storing the received purchase information in a first storing part"** and **"storing the received purchase information as valid purchase information in a second storing part** upon **the second sales information being stored in the first storing part"** as well as the other method operations rely upon information storing in a storage device, so it is readily apparent that the activity is central to the purpose of the invented method (see Interim Guideline II.B, definition of 'extra-solution').

Further, according to In re Bilski, "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfied §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article," In re Bilski, 88 USPQ2d 1385, 1396 and see Interim Guideline II.B.

The language of claims 1 and 11 require **"sales information"** and **"purchase information"** (claim 1), and **"deal identifying information"** (claim 11), which specify the type or nature of the data, and which in turn are representative of physical and tangible objects, namely evidence of sale/purchase of a merchandise or commodity. Further, the language of claims 1

and 11 specify how or from where the data (i.e., "**sales information**" and "**purchase information**" (claim 1) and "**deal identifying information**" (claim 11)) is obtained or what the data represents, for example, "**receiving a first sales information, which identifies a deal of a first commodity, from a retail seller of the first commodity ...**" (claim 1); and "**receiving from a retail seller a first deal identifying information that identifies the retail seller of a first commodity and identifies a time and place at which the first commodity was sold by the retail seller of the first commodity ...**" (claim 11).

The language of claim 1 transforms state of "purchase information" into different states of "valid," "invalid," or "unidentified validity," namely:

storing the received purchase information **as valid purchase information** in a second storing part upon the second sales information being stored in the first storing part;

storing the purchase information **as invalid purchase information** in the second storing part upon the second information of the purchase information having a deal number that is within the range of deal numbers between the minimum deal number of the second information and the maximum deal number of the second information; and

storing the purchase information **as unidentified validity purchase information** in the second storing part upon the second information of the purchase information not having a deal number within the range of deal numbers.

The language of claim 11 transforms state of "second deal identifying information" into different states of "invalid" or "validity ... not identified," namely:

storing, when it is judged that the deal number of the second deal identifying information falls within the range of deal numbers, the second deal identifying information, **together with an identifier as invalid information**, in a second storing part; and

storing, when it is judged that the deal number of the second deal identifying information does not fall within the range of deal numbers, the second deal identifying information **together with an identifier indicating a validity of the information is not identified**.

The claimed "**sales information**" and "**purchase information**" (claim 1) and "**deal identifying information**" (claim 11), specify the type or nature of the data, which in turn are representative of physical and tangible objects, namely evidence of sale/purchase of a merchandise or commodity. And the validity states of "**purchase information**" (claim 1) and "**second deal identifying information**" (claim 11) are transformed into different validity states,

providing a practical application to transform specific data. See In re Bilski, 88 USPQ2d 1385, 1397 and Interim Guideline II.B, definitions of 'article' and 'transformation'. Thus, the language of claims 1 and 11 comply with the In re Bilski 'transformation' part of the 'machine-or-transformation' test.

A prima facie case of unpatentability under 35 USC 101 cannot be established, because it is not more likely than not (i.e., by preponderance of evidence burden of proof - 37 CFR 1.56) that the claimed invention as a whole falls outside of one of the enumerated statutory classes in view of In re Bilski.

Reversal of the Examiner 35 USC 101 rejection is requested.

II. Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 are rejected under 35 USC 103(a) as being unpatentable over Quinlan (US Patent No. 6,748,365) in view of Solomon (US Patent No. 6,847,935). A second issue is whether the Office Action has established a prima facie case of obviousness of the independent claims 1, 7, 11, 16, 17, 20 and 21, based upon Quinlan and Solomon.

II.a. A first sub-issue of the second issue is whether the Office Action provides evidence expressly or implicitly which as a whole show that the legal determination sought to be proved (i.e., whether the reference teachings establish a prima facie case of obviousness) is more probable than not by the preponderance of evidence burden-of-proof standard (37 CFR 1.56(b)).

The Examiner Answer, item (10), page 11, is the Response to Arguments. Regarding the 1st sub-issue of the second issue, the Examiner Answer provides the Appeal Brief did not provide a specific explanation of what 'evidence' was missing. However, the issue is whether the obviousness over Quinlan and Solomon can be established by preponderance of evidence burden-of-proof - whether it is more likely than not (i.e., by preponderance of evidence burden of proof - 37 CFR 1.56) that the claimed invention as a whole is obvious in view of Quinlan and Solomon. The Appellant Appeal Brief arguments explained that it is not more likely than not that Quinlan and Solomon rendered obvious the claimed invention.

Further, the Examiner Answer, item (10), page 11, relies on KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (US 2007) (KSR) and alleges 'Claims 1, 19 & 27 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious

under KSR.’ Appellant notes that referring to claims 19 and 27 appears to be a typographical error, since claim 19 is cancelled and claim 27 does not exist since claim 21 is the highest numbered claim.

Appellant traverses the Examiner Answer with regard to KSR or what appears to be the obviousness rejection rationales (A), (D), (F) in MPEP 2141-III, because the claimed use of “a range of deal numbers” is not an old element, and, further, use of the “range of deal numbers” has the unpredictable result of discriminating between “*invalid*” and “*unidentified validity*” purchase information from a purchaser when the purchase information of the purchaser is not found in received sales information from a retail seller. More particularly, a readily evident unpredictable result is identification of “*unidentified validity*” purchase information.

The claim 1 language “a range of deal numbers of a second information” is not an old element, because Quinlan only discusses “a transaction serial number for a qualified transaction” (Abstract, column 9, line 18 to column 10, line 36) and Quinlan’s determination is necessarily based upon identical serial numbers for validating a rebate. In other words, Quinlan does not discuss expressly or implicitly use of a “range” of serial numbers as part of determining whether a rebate is valid. Further, Quinlan is silent on identifying various states of purchase information from a purchaser. Further, Quinlan column 10, lines 30-36 discuss checking a validated rebate claim for fraud against known databases, so Quinlan’s fraud checking step differs from the language of claim 1.

Further, Solomon is only relied upon for allegedly discussing status of a rebate, and Solomon column 5, lines 24-49 (relied upon by the Examiner) only discuss a ‘breakage refers to any event that prevents a rebate transaction from being completed, for example, denying based on bad verification materials, such as receipts or UPC symbols, denying based on improper purchase dates or purchase price, or slippage from checks issued but not cashed ...’ However, for example, Solomon does not discuss the details of a breakage based upon a UPC symbol and is silent on using a range of UPC symbols as part of rebate status determination.

The language of claim 1 changes a function of a deal number with respect to sales/purchase information of a commodity by utilizing “***a range of deal numbers of a second information***” extracted from sales information of the retail seller and from purchase information of the purchaser, in combination with a determination of whether sales information from the retail seller and purchase information from the purchaser do not correspond, which yield the unpredictable result/benefit of the present invention of identifying submissions of purchase

information using deal numbers that are within range but without any corresponding original sales information, namely ***“extracting sales information containing a first information of the purchase information from said first storing part upon the second sales information ... not being stored in the first storing part, including [extracting from the sales information (added language for emphasis)] a range of deal numbers of a second information between a minimum deal number of the second information to a maximum deal number of the second information”*** and ***“storing the purchase information as invalid ... upon ... having a deal number that is within the [extracted (added language for emphasis)] range of deal numbers between the minimum deal number of the second information and the maximum deal number of the second information ...”*** (e.g., independent claim 1). Further, the language of claim 1 provides ***“storing the purchase information as unidentified validity purchase information ... upon ... not having a deal number within the [extracted (added language for emphasis)] range of deal numbers”*** (e.g., independent claim 1).

A benefit of the invention is to identify as “invalid” or “unidentified validity” the submitted purchase information from a purchaser, namely, if the “second sales information” that is included in the received purchase information from the purchaser, is not stored in said first storing part, namely not stored in the original sales information database 17 transmitted by the retailer seller 3. But if the range of deal numbers extracted from said first storing part, namely extracted from the original sales information database 17 transmitted by the retailer seller 3, is within a range of deal numbers from the “second sales information,” then since there is no possibility that the original sales information corresponding to the received purchase information has not yet been transmitted by the retailer (i.e., in other words, the original sales information of the retailer corresponding to the received purchase information from the user should have been transmitted), the received purchase information from the user must be “invalid.” In other words, if the purchaser input deal numbers are within range of the received sales information from the retail seller, but the sales information do not match, then there is no possibility that the original sales information corresponding to the received purchase information has not yet been transmitted by the retailer (i.e., the original sales information should have been transmitted, if the deal number of the purchase information from the purchaser are within range of the received sales information from the retail seller), so the received purchase information must be “invalid.” See FIG. 13 (steps 508, 506) and page 24, lines 6-17 and page 27, lines 13-19.

Further, if the range of deal numbers extracted from said first storing part, namely extracted from the original sales information database 17 transmitted by the retailer seller 3, is not within a range of deal numbers from the "second sales information," then the submitted purchase information is identified as "**unidentified validity**," which is different from an "invalid" status of the purchase information from the purchaser. A benefit of this new and unpredictable purchaser purchase information state of "**unidentified validity**" is to indicate that the reliability of the purchase information from the purchaser cannot be identified, so that the purchase information investigation, for example, there is a possibility that the corresponding sales information may not have been transmitted from the retail seller, can be more focused on possibly unreliable purchase information, rather than must be "invalid" purchase information (see, for example, page 16, lines 1-10; page 23, line 22 to page 24, line 17; and page 27, lines 13-29 of the present Application).

Further, even if assuming the limitations of claim 1 are all old elements, as discussed above, the combination of the required limitations of claim 1 is more than the predictable use of prior art elements according to their established functions (see MPEP 2141-I, 2141-III (Rationales to Support Rejections Under 35 USC 103 - (A)-(G))). Because by utilizing "**a range of deal numbers of a second information**," which are **extracted from sales information of the retail seller** and **from purchase information of the purchaser**, in combination with determining whether sales information from the retail seller and purchase information from the purchaser do not correspond, yields the unpredictable result/benefit of the present invention of identifying submissions of purchase information using deal numbers that are within range but without any corresponding original sales information, namely "**extracting sales information containing a first information of the purchase information from said first storing part upon the second sales information** ... not being stored in the first storing part, including [extracting from the sales information (added language for emphasis)] a range of deal numbers of a second information between a minimum deal number of the second information to a maximum deal number of the second information" and "**storing the purchase information as invalid** ... upon ... having a deal number that is within the [extracted (added language for emphasis)] range of deal numbers between the minimum deal number of the second information and the maximum deal number of the second information ..." (e.g., independent claim 1). Further, the language of claim 1 provides "**storing the purchase information as unidentified validity purchase information** ... upon ... **not having a deal number within the** [extracted (added language for emphasis)] **range of deal numbers**" (e.g., independent claim 1).

Further, regarding the obviousness rejection rationale MPEP 2141-III-(E), it would not be obvious to try the language of claim 1, because it is readily apparent there are not a finite number of identified, predictable solutions to determine and designate a status of "purchase information" from a purchaser in relation to sales information from a retail seller. In other words, there are numerous possible choices of criteria for transforming state of "purchase information" into different states of "**valid**," "**invalid**," or "**unidentified validity**," and it would not be obvious to try providing the language of claim 1:

storing the received purchase information **as valid purchase information** in a second storing part upon the second sales information being stored in the first storing part;

storing the purchase information **as invalid purchase information** in the second storing part upon the second information of the purchase information having a deal number that is within the range of deal numbers between the minimum deal number of the second information and the maximum deal number of the second information; and

storing the purchase information **as unidentified validity purchase information** in the second storing part upon the second information of the purchase information not having a deal number within the range of deal numbers.

In addition, Quinlan's discussion of using identical transaction serial numbers for a qualified transaction (column 10, lines 6-29) and Solomon's discussion of status of a rebate (column 6, lines 38-48) do not guide an inventor at the time of the present invention to try, or be predictable, or to consider as a viable option the claimed utilizing "**a range of deal numbers of a second information**," which are **extracted from sales information of the retail seller and from purchase information of the purchaser**, in combination with determining whether sales information from the retail seller and purchase information from the purchaser do not correspond, for yielding the unpredictable result/benefit of identifying submissions of purchase information using deal numbers that are within range but without any corresponding original sales information. See Bayer Schering Pharma AG v. Barr Laboratories, Appeal No. 2008-1281 (Fed. Cir. Aug. 5, 2009).

Thus, it is not more likely than not (i.e., by preponderance of evidence burden of proof - 37 CFR 1.56) that one skilled in the art would combine Quinlan with Solomon to use "**a range of deal numbers**" for achieving the unpredictable result of discriminating between "**invalid**" and "**unidentified validity**" purchase information when purchase information of a purchaser is not found in received sales information from a retail seller. More particularly, a readily evident

unpredictable result is identification of “**unidentified validity**” purchase information. Reversal of the Examiner rejection is requested.

Independent claims 7, 11, 16, 17, 20 and 21 require limitations of “**invalid**” and “**unidentified validity**” identifier statuses similar to the discussed limitations of claim 1.

II.b. A second sub-issue of the second issue is whether the Office Action sets forth reasoning in support of a prima facie case of obviousness of the claims based upon Quinlan and Solomon.

As a first error, the Examiner has not provided any evidence or reasoning that claim 1 phrase “**a range** of deal numbers of a second information” is an old element or prior art element.

Further, as a second error, the Examiner has not provided any evidence or reasoning that claim 1 phrase “**a range** of deal numbers of a second information” is not a changed function alone as well as in combination with other elements of claim 1 with respect to Quinlan’s a serial number, UPC codes, correct purchased item, qualifying period, price range (column 9, line 17 to column 10, line 36), and/or with respect to Solomon’s breakage (column 5, lines 24-38), and which yields a predictable result.

But the Examiner Answer page 11 provides a conclusory statement that all of claim 1 language is old elements with no change in their respective functions and which yield predictable results. However, a prima facie case of obviousness based upon conclusory statements cannot be established (see MPEP 2141-III, citing KSR). Reversal of the Examiner rejection is requested, because of these two errors by the Examiner.

Therefore, it is submitted that claims 1, 7, 11, 16, 17, 20 and 21 as well as claims 2-4, 6-9 and 12, which depend therefrom, are patentably distinguishable over the prior art of record.

Appellant submits that pending appealed claims patentably distinguish over the relied upon prior art. Reversal of the Examiner's rejections is requested.

Respectfully submitted,
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/Mehdi D. Sheikerz/

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